

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: KEVAN C. TAYLOR

Serial No.: 08/604,975

Filed: March 25, 1996

International Application No.: PCT/GB94/00995

International Filing Date: 9 May 1994

For: LINING OF PIPELINES OR
PASSAGEWAYS

RECEIVED

29 JAN 1997

Legal Staff
International Division

Date: January 28, 1997

THIRD SUPPLEMENTAL SUBMISSION IN SUPPORT OF
RENEWED PETITION UNDER 37 C.F.R. § 1.47(b)
IN RESPONSE TO DECISION ON PETITION
PURSUANT TO 37 C.F.R. § 1.47(b) DATED 12 JULY 1996

Assistant Commissioner for Patents
Box PCT
Washington, D.C. 20231

Attention: PCT Legal Office

S I R:

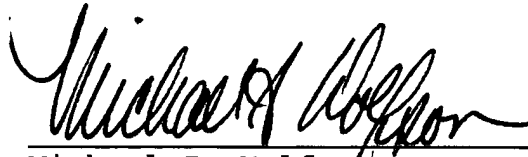
This Third Supplemental Submission In Support Of Renewed Petition is submitted along with my Declaration dated January 28, 1997 to report to the PCT Legal Office of a letter received by us today from Kevan C. Taylor.

Mr. Taylor acknowledged receipt of my letter requesting that he sign the Declaration and Assignment in connection with the application. However, he has not done so. Accordingly, our earlier request to prosecute this application 37 C.F.R. § 1.47(b) is respectfully restated.

Mr. Taylor's letter to us received today, January 28, 1997 and my response to him is annexed to my accompanying Third Supplemental Declaration.

Early and favorable action is earnestly solicited.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Michael I. Wolfson", written over a horizontal line.

Michael I. Wolfson
Reg. No. 24,750
Attorney for Petitioner and
37 C.F.R. § 1.47(b) Applicant
COWAN, LIEBOWITZ & LATMAN, P.C.
1133 Avenue of the Americas
New York, New York 10036-6799
(212) 790-9200

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: KEVAN C. TAYLOR
Serial No.: 08/604,975
Filed: March 25, 1996
International Application No.: PCT/GB94/00995
International Filing Date: 9 May 1994
For: LINING OF PIPELINES OR
PASSAGEWAYS

**THIRD SUPPLEMENTAL DECLARATION OF MICHAEL I. WOLFSON
IN SUPPORT OF RENEWED PETITION UNDER 37 C.F.R. § 1.47(b)**

Assistant Commissioner for Patents
Box PCT
Washington, D.C. 20231

Attention: PCT Legal Office

S I R:

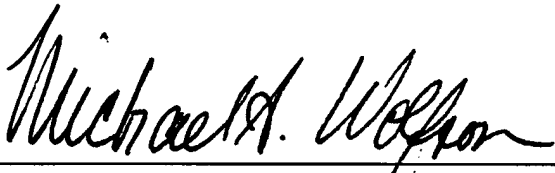
1. This Third Supplemental Declaration supplements my prior Declarations of January 9, 1997 and January 20, 1997.

2. Today, I received a letter from Kevan C. Taylor, a copy of which is annexed hereto as Exhibit 1.

3. I have written to Mr. Taylor today, a copy of which is annexed hereto as Exhibit 2. As noted in this latest letter to Mr. Taylor, we have restated our request to him to sign the Declaration and Assignment in connection with this application. In response to his request, I have forwarded to him a copy of his Employment Agreement. I have also advised him of ownership of the invention in the underlying priority application in Insituform pursuant to the Patents Act of 1977 (as amended by the Copyright Designs and

Patents Act 1988) and his Employment Agreement dated 19 July 1993 with Insituform Technologies, Inc.

4. I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements are made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.


MICHAEL I. WOLFSON

Date: New York, New York
January 28, 1997

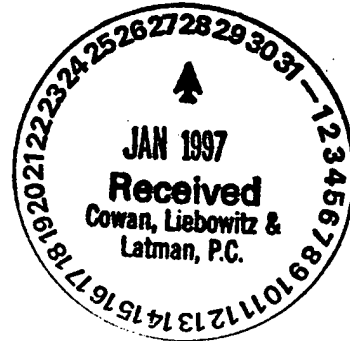
Exhibit 1

Mr. Kevan C. Taylor
4251 Young
Pasadena, TX 77504

COPY

January 27, 1997

Cowan, Liebowitz & Latman, P.C.
Attn.: Michael I. Wolfson
1133 Avenue of the Americas
New York, NY 10036-6799



Dear Mr. Wolfson,

I am in receipt of your letter requesting assignment of patent application
No. PCT/GB94/00955 for the United States National phase application Serial
No. 08/604,975.

Your comments regarding your ability to locate my whereabouts are unwarranted and not substantiated, especially since you could not even get the correct address of my previous residence correct even though it was used for a mortgage application, in addition to which several people in Memphis have known my whereabouts for the last couple of years.

Please forward copies of any agreements that confer that I must assign any right of this invention to the assignee.

Thank you for your cooperation regarding this matter.

Sincerely,

A handwritten signature in cursive script that reads "K Taylor".

Kevan C. Taylor

Exhibit 2

Cowan, Liebowitz & Latman, P.C.

LAW OFFICES

1133 Avenue of the Americas • New York, NY 10036-6799

Telephone (212) 790-9200 • Internet law@cll.com • Fax (212) 790-9300

Michael I. Wolfson

Direct (212) 790-9201

miw@cll.com

January 28, 1997

BY FEDERAL EXPRESS

Mr. Kevan C. Taylor
4251 Young
Pasadena, Texas 77504

Re: U.S. Application Serial No. 08/604,975
Based on International Patent Application
No. PCT/GB94/00955
LINING OF PIPELINES AND PASSAGEWAYS (Short-Tee Repair)
Insituform (Netherlands) BV
Our Ref. ITI-169 (20107.69)

Dear Mr. Taylor:

Thank you for your letter dated January 27, 1997.

You indicate that you are in receipt of our letter requesting that you sign a Declaration and Assignment in connection with U.S. application Serial No. 08/604,975.

We reiterate our request that you sign and return these documents to us in the enclosed pre-paid Federal Express envelope.

This United States application claims priority of British application No. 9319823.3 filed on 25 September 1993. At that time, you were employed by Insituform Technologies, Inc. ("ITI") pursuant to an Employment Agreement dated 19 July 1993. A copy of that Agreement which you signed on 19 July 1993 is enclosed for your information.

Paragraph 13 of your Agreement with ITI provides that pursuant to the Patent Act of 1977 and the Copyright Designs and Patents Act 1988, any invention produced during the course of your employment is the exclusive property of Insituform. From 4 December 1989 and your initial employment by Insituform Technical Services Limited until that Agreement with ITI, your employment has been governed by

Cowan, Liebowitz & Latman, P.C.

Mr. Kevan C. Taylor

January 28, 1997

Page 2

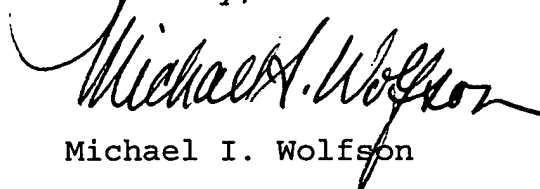
the Patents Act 1977 (as amended by the Copyright Designs and Patents Act 1988). This Act provides that any inventions made after June 1, 1978 by an employee, mainly employed in the United Kingdom shall belong to the employer. Thus, so long as the invention was made during employment with any of the Insituform companies, the underlying invention is the exclusive property of your employer, one of the Insituform companies.

In view of this, we again renew our request that you sign the Declaration and Assignment and return them to us for filing in the United States Patent and Trademark Office. A new set of the application papers including your new address is enclosed for your convenience. Please sign and date the Declaration at page 2 and have the Assignment notarized. If you incur any expenses in connection with this, let us know so we can reimburse you.

Please also note that we have advised the PCT Legal Office at the United States Patent and Trademark Office of our receipt of your letter of January 27, 1997 and this response.

Thank you for your cooperation in this matter.

Sincerely,

A handwritten signature in black ink, appearing to read "Michael I. Wolfson", written over a horizontal line.

Michael I. Wolfson

Enclosures

cc: Insituform Technologies, Inc.
Memphis, Tennessee

ASSIGNMENT OF UNITED STATES PATENT APPLICATION

WHEREAS, KEVAN CHARLES TAYLOR, a citizen of Great Britian and last residing at 4251 Young, Pasadena, Texas 77504, is the inventor of the improvements and invention described in the PCT Application No. PCT/GB94/00995 filed 4 May 1994 and British application filed in the British Patent Office as application number 9319832.3 on 25 September 1993 for LINING OF PIPELINES AND PASSAGEWAYS, and filed in the U.S. Patent and Trademark Office on March 25, 1996 and assigned Serial No. 08/604,975.

WHEREAS, Insituform (Netherlands) B.V., a coproration organized under the laws of The Netherlands and Delaware, having its principal office at West Blaak 6, 3rd Floor, 3012KK, Rotterdam, The Netherlands, hereinafter referred to as ASSIGNEE, is desirous of acquiring the entire right, title and interest in, to and under the improvements and invention described in PCT Application No. PCT/GB94/00995 and the United States National Phase application Serial No. 08/604,975 from ASSIGNOR.

NOW, THEREFORE, in consideration of the sum of Ten Dollars (\$10.00) and other good and valuable consideration paid by ASSIGNEE to ASSIGNOR, the sufficiency and receipt of which is hereby acknowledged, ASSIGNOR hereby transfers and assigns to ASSIGNEE the entire right, title and interest in, to and under the improvements and invention described in the United States National Phase application based on PCT/GB94/00995 filed in the U.S. Patent and Trademark Office and all continuations, divisionals, substitutes, renewals and reissues thereof; and

ASSIGNOR covenants that he has full rights to convey the entire interest herein assigned, and has not executed, and will not execute, any agreement in conflict herewith; and

ASSIGNOR further authorize the Commissioner of Patents and Trademarks of the United States, to record ownership in the U.S. national phase application based on U.S. PCT Application No. PCT/GB94/00995 as the property of ASSIGNEE; and

ASSIGNOR further covenants and agrees that he will communicate to the ASSIGNEE, its successors, legal representatives and assigns, any facts known to it respecting the improvements, and testify in any legal proceeding, sign all lawful papers, execute all divisional, continuing and reissue applications, make all rightful oaths and generally do everything possible to aid the ASSIGNEE, its successors, legal representatives and assigns, to obtain and enforce proper patent protection for the improvements.

IN WITNESS WHEREOF, ASSIGNOR has subscribed hereto, this ____ day of January, 1997.

KEVAN CHARLES TAYLOR

On this ____ day of January, 1997 before me came KEVAN CHARLES TAYLOR to me known and known to me to be the individual described in, and who executed the foregoing instrument, and he has acknowledged to me that he has executed the same.

Notary Public

DECLARATION, POWER OF ATTORNEY AND PETITION

As an officer of the owner of the invention and Agent of the below named inventor, I hereby declare that:

My residence, post office address and citizenship are as stated below next to my name.

I believe that the below named inventor is the original, first and sole inventor (if only one name is listed below) or an original, first and joint inventor (if plural names are listed below) of the subject matter which is claimed and for which a patent is sought on the invention entitled:

IMPROVEMENTS RELATING TO THE LINING OF PIPELINES OR PASSAGEWAYS

the specification of which is attached hereto and was filed on 9 May 1994 as PCT/GB94/00995 and is based on an application filed in the British Patent Office as British Application No. 9319832.3 on 25 September 1993 and filed in the United States Patent and Trademark Office as Serial No. 08/604,975 on March 25, 1996.

I acknowledge the duty to disclose information which is material to the examination of this application in accordance with Title 37, Code of Federal Regulations, Section 1.56.

I hereby claim foreign priority benefits under Title 35, United States Code, Section 119 of any foreign application(s) for patent or inventor's certificate listed below and have also identified below any foreign application for patent or inventor's certificate having a filing date before that of the application on which priority is claimed.

Prior Foreign Applications				
(Number)	(Country)	Day/Month/Year	Yes	No
9319832.3	Great Britain	25 Sept 1993	X	
PCT/GB94/00995	Great Britain	9 May 1994	X	

I hereby claim the benefit under Title 35, United States Code, Section 120 of any United States application(s) listed below and, insofar as the subject matter of each of the claims of this application is not disclosed in the prior United States application in the manner provided by the first paragraph of Title 35, United States Code, Section 112, I acknowledge the duty to disclose material information as defined in Title 37, Code of Federal Regulations, Section 1.56 which occurred between the filing date of the prior application and the national or PCT international filing date of the application.

(App Ser No)

(Filing Date)

(Status)

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that

these statements are made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

And I hereby appoint Michael I. Wolfson, Reg. No. 24,750, William H. Dippert, Reg. No. 26,723, R. Lewis Gable, Reg. No. 22,479, Morey B. Wildes, Reg. No. 36,968 and Regan L. Trumper, Reg. No. 38,345, correspondence address:

MICHAEL I. WOLFSON
Cowan, Liebowitz & Latman, P.C.
1133 Avenue of the Americas
New York, New York 10036

Telephone: (212) 790-9200

my attorney with full power of substitution and revocation, to prosecute this application and to transact all business in the Patent and Trademark Office connected therewith.

Wherefore I pray that Letters Patent be granted for the invention or discovery described and claimed in the foregoing specification and claims, and I hereby subscribe my name to the foregoing specification and claims, declaration, power of attorney, and this petition.

FULL NAME OF INVENTOR KEVAN CHARLES TAYLOR	CITIZENSHIP Great Britain
RESIDENCE 4251 Young, Pasadena, Texas 77504	
POST OFFICE ADDRESS 4251 Young, Pasadena, Texas 77504	
INVENTOR'S SIGNATURE	DATE



Insituform
Technologies

EMPLOYMENT AGREEMENT

This Agreement is made the 19th day of July 1993 between Insituform Technologies, Inc., 1770 Kirby Parkway, Suite 300, Memphis, Tennessee 38138 (the "Company") and Kevan Taylor residing at 4 Purbeck Road, Rushden, Northants NN10 9UH, England (the "Employee").

IT IS HEREBY AGREED AS FOLLOWS:

1. The Employee is employed by the Company in the position of Technology Transfer Manager or in such other capacity as the Company may reasonably require and the duties of the position will involve:
 - (1) technology transfer to licensees worldwide;
 - (2) management of technology transfer team (contracts);
 - (3) negotiation of sales of specialized related equipment;
 - (4) liaison with all General Managers and technical consultants including Research and development.

The Employee will attend and work at any of the Company's locations in the United Kingdom as determined from time to time by SBU (Strategic Business Unit) Product Management and will travel to and work at such places (whether within or outside the United Kingdom) in the manner and on the occasions required from time to time by the Company provided that the Company will not, without the Employee's prior consent, require the Employee to reside or work (other than temporarily) outside the United Kingdom. During the Employee's employment, the Employee will work from home or, a mutually agreed location until further notice, utilizing secretarial services at Insituform Permaline and ITI Memphis.

2. The Employee's employment with Insituform Group Limited will count towards continuity of employment with the Company. The Employee will participate in all standard Company benefit programs appropriate for the United Kingdom. Accordingly, the Employee's period of continuous employment commenced on December 4, 1989. The Employee's employment is subject to termination by either party on not less than three (3) months written notice (or the statutory minimum period of notice if greater) to be given at any time. The Company reserves the right to terminate the Employee's employment by payment in lieu of notice.
3. The Employee will be required to work such hours as may be necessary for the proper discharge of the Employee's duties hereunder. The Employee's normal working hours will be 9:00 a.m. to 5:30 p.m., Monday to Friday.
4. The Employee's annual salary will be £36,250 per annum, commencing August 1, 1993, (the "Effective Date") which shall accrue from day to day and be payable in arrears by equal monthly installments on the 24th day of each month. The Employee's annual salary will be reviewed from time to time and the rate thereof may be increased with effect from any such review date. It is understood that the first such review will be six months from the Effective Date of this Agreement.
5. In addition to the usual bank and public holidays the Employee will be entitled to 25 working days holiday in each year to be taken at a time or times to be agreed upon with the Company. In the year in which the Employee's employment with the Company commences and terminates the Employee's holiday entitlement will be pro rata to the annual entitlement. The holiday year shall run from the 1st of January to the 31st of December. Holiday may be carried forward from the previous year up to the 5th of May of the following year. On termination of employment a payment in lieu of any untaken holiday will be made and if the

Employee has taken holiday in excess of the Employee's entitlement the Company reserves the right to make a deduction from the Employee's final salary payment.

6. If the Employee is absent from the Employee's duties hereunder owing to illness or injury the Employee must report this fact promptly to his immediate superior and will on request complete a self-certification form. For any absence exceeding 7 days the Employee will produce a doctor's certificate. Subject to compliance with these provisions, the Company, at its discretion, will continue to pay the Employee at the Employee's normal rate of salary less any statutory sick pay and any social security benefits to which the Employee may be entitled.
7. There is a pension scheme in operation in relation to the Employee's employment hereunder which is held now by Allied Dunbar. A contracting out certificate pursuant to the provisions of the Social Security Pensions Act 1975 is in force in respect of the Employee's employment hereunder.
8. The Company will pay for the provision to the Employee of the following insurance and other benefits, particulars of which may be obtained from the Company:
 - (a) Medical insurance in accordance with arrangements made between the Company and PPP, Ltd.;
 - (b) Life Assurance with Sun Alliance; and,
 - (c) Permanent Health Insurance with [_____].
9. The Company will provide the Employee with a motor car for the Employee's business and personal use during the continuance of the Employee's employment. The Company will pay all taxation, insurance premium, maintenance expenses and all petrol oil and other running expenses. The Employee will pay for petrol

and oil required when the car is used for holidays. The car will be replaced in accordance with the Company's policy on cars.

10. On production of appropriate receipts, the Company will reimburse the Employee for all travelling, hotel, entertainment and other expenses properly and reasonably incurred by the Employee in the performance of the Employee's duties hereunder.
11. Should it become necessary to institute any disciplinary action against the Employee this will be done in the first instance by his immediate superior. The type of conduct which may lead to disciplinary action includes poor time-keeping, absenteeism and sub-standard work performance. The Company reserves the right to terminate the Employee's employment without notice in the event of any serious misconduct. Examples of serious misconduct include dishonesty, misuse of any of the Company's proprietary information and unauthorized absence.
12. If the Employee has any problem or grievance pertaining to the Employee's employment or any disciplinary action taken against the Employee, the Employee should discuss it in the first instance with the Employee's immediate superior.
13. (a) Subject to the Patent Act of 1977 and the Copyright, Designs and Patents Act 1988 any invention, design or copyright work produced by the Employee during the course of the Employee's employment with the Company whether or not in the course of the Employee's duties will be the exclusive property of the Company. For purposes of section 39(1)(b) Patents Act 1977 the Employee will be deemed to have a special obligation to further the interests of the Company provided that this sub-clause will not derogate from the Employee's statutory rights in relation to such inventions. In relation to such work the Employee irrevocably waives all moral rights and undertakes, at the expenses of the Company, to

execute any formal and additional assignment required by the Company to confirm the vesting in it of all rights in any such invention, design or copyright work.

- (b) To secure the Employee's obligations hereunder the Employee hereby irrevocably appoints the Company to be the Employee's attorney and in the Employee's name and on the Employee's behalf to execute any such instrument or do any such thing and generally to use the Employee's name for the purpose of giving to the Company or its nominee the full benefit of the provisions of this clause and with respect to any third party a certificate in writing signed by any director or the company secretary and any instrument or act falls within the authority hereby conferred will be conclusive evidence that such is the case.
14. The Employee will be expected to devote best efforts to the position with the Company and the Employee shall not, without the prior written consent of his immediate superior, engage in any other employment or activities which may conflict with the Employee's obligations to the Company.
15. Both during the Employee's employment and after its termination the Employee will keep secret and will not use, disclose or divulge to any third party any of the trade secrets of the Company or any confidential information or information concerning the business, affairs, finance, products, research customers or trade connections of the Company. The Employee will also use best endeavors to prevent the unauthorized publication or disclosure or any such secret, knowledge or information.
16. Upon the termination of employment the Employee will immediately deliver up to the Company all property belonging to it which is or has been in the Employee's possession or under the Employee's control.

17. The Company has the right at any time to set off against any monies due to the Employee, all sums owing by the Employee to the Company, whatsoever arising.
18. This Agreement will be governed by English law.

IN WITNESS WHEREOF this document has been executed as a deed the day and year first before written.

SIGNED AND DELIVERED

as a Deed by
Kevan Taylor
in the presence of:

)
)
)
)

K Taylor 19th July 93
Scott W. Triplett 19th JULY 93

EXECUTED as a Deed by
F. Thomas Driver, P.E.
Senior Vice President-Manufacturing
for an on behalf of
Insituform Technologies, Inc.
in the presence of:

)
)
)
)
)
)

F. T. Driver 19th July 93
Scott W. Triplett 19th JULY 93

Exhibit B

C.I.P.A. GUIDE TO THE PATENTS ACTS

TEXTS, COMMENTARY AND
NOTES ON PRACTICE

FOURTH EDITION

THE CHARTERED INSTITUTE
OF PATENT AGENTS



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el Aviv
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i, Lahore

PART I, SECTION 38]

within two months from the date of the order if made by an old proprietor and four months if made by a former licensee. These periods are, however, extensible at the Comptroller's discretion under rule 110(1), for which see para. 123.36. Since the request is to be made directly to the new proprietor, no form is specified for the request. Nor is it required that the Comptroller be notified of the request, though it may be prudent to do so, but the request would then become of public record on the file of the patent. Rule 57 is analogous to rule 9 (reprinted at para. 8.04 and discussed in para. 11.05).

Any reference to the Comptroller, either by the new proprietor or the person seeking a licence, is to be made on PF 2/77 (reprinted at para. 140.02) under rule 58 (reprinted at para. 38.03). This rule is analogous to rule 13 (reprinted at para. 11.02 and discussed in para. 11.06).

Employees' Inventions (Sections 39-43)

39.01

SECTION 39

Right to employees' inventions

39.—(1) Notwithstanding anything in any rule of law, an invention made by an employee shall, as between him and his employer, be taken to belong to his employer for the purposes of this Act and all other purposes if—

- (a) it was made in the course of the normal duties of the employee or in the course of duties falling outside his normal duties, but specifically assigned to him, and the circumstances in either case were such that an invention might reasonably be expected to result from the carrying out of his duties; or
- (b) the invention was made in the course of the duties of the employee and, at the time of making the invention, because of the nature of his duties and the particular responsibilities arising from the nature of his duties he had a special obligation to further the interests of the employer's undertaking.

(2) Any other invention made by an employee shall, as between him and his employer, be taken for those purposes to belong to the employee.

(3) Where by virtue of this section an invention belongs, as between him and his employer, to an employee, nothing done—

- (a) by or on behalf of the employee or any person claiming under him for the purposes of pursuing an application for a patent, or
- (b) by any person for the purpose of performing or working the invention,

shall be taken to infringe any copyright or design right to which, as between him and his employer, his employer is entitled in any model or document relating to the invention.

Note. Subsection (3) was inserted by Schedule 5, para. 11(1) (1988), with effect from January 7, 1991 (S.I. 1990 No. 2168).

[PART I, SECTION 39

COMMENTARY ON SECTION 39

General scope of provisions for "employees' inventions" (ss. 39-43)

39.02

Section 39 is the first of a group of sections (ss. 39-43) headed "Employees' Inventions". This group defines a self-contained code for determining ownership of an "invention" (s. 39); regulates circumstances in which it would be "just" for an employer of such an "employee" to make payments, curiously termed "compensation", to that employee for the benefit which the employer has derived from a "patent" which has been granted for an "invention" made by the "employee" (s. 40); lays down guidelines for determining the *quantum* of such compensation (s. 41); renders unenforceable certain clauses in contracts of employment widely used before 1978 (s. 42); and limits the applicability of this group of sections to inventions made on or after June 1, 1978 and by persons "mainly employed" in the United Kingdom (including the Isle of Man). Some of the words in quotation marks in the preceding sentence are defined in section 43 (which is, in effect, a mini-interpretation section of ss. 39-42) and in section 130(1). These all receive discussion below and in the commentaries on the following sections 40-43.

The provisions of sections 39-43 were summarised, from the point of view of industrial relations, in a paper by Susan Cox ((1991) 3(1) IPB 2).

Scope of section 39

39.03

Section 39 is a provision of substantive, rather than procedural, law. It has effect in relation to the settlement of entitlement disputes under section 8, 12, 37 or 82; and to the question of "compensation" under section 40. It relates to rights in inventions made after June 1, 1978 (s. 43(1)) by persons normally resident in the United Kingdom (s. 43(2)), and has effect in relation to "patents and other protection" generally irrespective of where or how granted, see section 43(4) and para. 43.05. In all these matters it must first be decided who is the "inventor", a question on which the Act gives very little guidance, see para. 7.06 and the article by R. P. Lloyd noted therein. Section 39 then settles the question of ownership of inventions made by persons who are "employees", as between an employee and his "employer", provided that the invention was made by a person "mainly employed" in the United Kingdom (s. 43(2), as discussed in para. 43.03).

However, section 39 has no effect upon the ownership of inventions made before June 1, 1978 (s. 43(1)) and is therefore entirely inapplicable to "existing patents". The resolution of employee/employer disputes in relation to such patents continues to be determined under section 56 (1949), see paras. A056.03-A056.09. There are no provisions in the EPC, CPC or PCT relating to ownership of patent rights in inventions made by employees. These remain to be determined by individual national laws, generally (it is believed) applicable only to persons normally employed in the country in question. By the same token, section 39 relates to the ownership of patent rights anywhere in the world resulting from an invention made by a person who, at the time of making the invention (as to which, see para. 7.06), was "mainly employed" in the United Kingdom (see para. 43.03).

Section 39 also has no applicability to inventions made by non-employees. The disposition of patent rights arising from inventions made by such persons, however, remains subject to possible contractual obligations, for example in the case of research work commissioned from a non-employee. A contract between an employer and a third party concerning the disposition of patent rights of employee inventions can have no effect on patent rights which belong to an employee under subsection (1). That contract may then become incapable of fulfilment, the

PART 1, SECTION 39]

consequences of which will depend upon the default provisions therein and the doctrine of frustration in the law of contract.

39.04 Meaning of "invention" in sections 39-43

"Invention" (as used in s. 39) is a term clearly wider than "patentable (or patented) invention", but is not defined: sections 1, 125 and 130, *inter alia*, deal only with inventions for which a patent under the Act has been applied for or granted. In *Vizball's Application* ([1988] RPC 213), it was held that "invention", as used in section 8, encompasses unpatentable subject-matter, whether because already known or because expressly excluded from the ambit of the Act (e.g. by ss. 1(2), 1(3) or 4(2)). For the purposes of section 39, it is immaterial whether a patent application has been filed or not. Note the phrase in the introductory part of subsection (1) "for ... all other purposes"; and the reference in section 43(4) to "other protection", particularly now that this provision had been amended specifically to relate also to section 39, see paras. 39.13 and 43.05.

This wide meaning of "invention" may well encompass many "suggestions" submitted by employees under company suggestion schemes. Care should, therefore, be taken to ensure that any rules of such schemes purporting to regulate the ownership of the submitted suggestions remain in harmony with the provisions of section 39. The effect of section 42(2) may also need to be considered, see para. 42.03, and of section 42(3), see para. 42.04. Although not a section 39 case, the nature and effect of the law of confidence in relation to suggestion schemes was examined in *Prou v. British Gas* ([1992] FSR 478).

39.05 Meaning of "employee" for sections 39-43

"Employee" is defined for the purposes of the Act in section 130(1) by reference to a contract of employment, a definition closely similar to that in section 153 of the Employment Protection (Consolidation) Act 1978 (c. 44), but this definition was extended by the Armed Forces Act 1981 (c. 55), by amendment of section 42(4) and 130(1) by adding the words thereto "or a person who serves (or served) in the naval, military or air forces of the Crown" (see paras. 42.01 and 130.01), thereby equating members of the armed forces to employees [of the Crown] for the purposes of sections 39-43.

Also, the 1988 Act defines "employee", though for the purposes of copyright and design law only, as referring to employment "under a contract of service or of apprenticeship" (s. 176 and 263(1) [1988]), thereby raising a doubt as to the position of apprentices in relation to the ownership of inventions made by them.

39.06 The status of the inventor as employee

In most cases, the status of the inventor as employee is not in doubt, but difficult problems can arise with regard to directors (*Parsons v. Parsons*, [1979] FSR 254), who are not necessarily employees (*Parr's Patents*, SRIS O/46/94) and also with consultants, and the increasing number of "home workers". In such cases one must first determine if there is a contract at all, and then, if so, whether the contract is one "of service" or "for services". The question is one of law rather than fact (*Davies v. Presbyterian Church of Wales*, [1986] 1 WLR 323; [1986] IRLR 194 (HL)). An equity-holding partner in a firm is an employer of its staff and cannot therefore be said to be employed by it himself, but the ownership of shares in a company, even by a majority shareholder, is irrelevant as the company is an equity quite separate from its members (*Salomon v. Salomon & Co. Ltd.*, [1897] AC 22 (HL)).

[PART 1, SECTION 39]

Given the crucial difference in treatment of employees for tax and national insurance purposes, as well as for entitlement to social security benefits and employment protection rights (e.g. as regards redundancy, unfair dismissal, health and safety provisions, protection of pay when the employer becomes insolvent, etc.), a huge body of case law on the point has built up in employment law. To summarise it here is beyond the scope of this commentary, but in one of the leading cases (*O'Kelly v. Trusthouse Forte*, [1984] QB 90; [1983] 3 All ER 456 (CA)) it was said that, in order to determine employee status, all aspects of the relationship must be considered and no single factor is in itself decisive. One such factor is the label the parties themselves put on the relationship (*Marich Property v. Comm. of Pay-Roll Tax*, [1984] ICR 285 (PC), following *Massey v. Crown Life Insurance*, [1978] 1 WLR 676; [1978] 2 All ER 576 (CA)). No single test is adequate in all circumstances, e.g. not the older "control" or master-and-servant test, but currently courts favour the so-called "economic reality" (or "mixed") test, see *Lee Ting Sang v. Chung Chi-Keung* ([1990] 2 AC 374 (PC)), although that case involved compensation for employee injury where the plaintiff wished to be considered as an employee, whereas the opposite may be true in a case under section 39. The question in its simplest form is whether the person doing the work is in business on his own account or not; and whether there are mutual obligations between the alleged employer and alleged employee.

Cases in which it was held that a creator was not an employee at the relevant time are: *Coffey's Registered Designs* ([1982] FSR 227), where the designer was at the time only a partner in an informal partnership under no trust obligation thereto or to a company incorporated only subsequently, and *Gleave's Patent* (SRIS O/72/88), where a referrer (in a 37 proceedings) failed to prove that the patent proprietor was an employee at the relevant time and where it appeared that the alleged employer company had not then been incorporated. In *Stibbocell's Applications* (SRIS O/3/91, noted TPD 14101), the referrer in entitlement proceedings failed to prove that he had made the invention during a short period when he was unemployed following redundancy from, and liquidation of, his former employer and his re-engagement by the successor thereto.

Where an employee is seconded by the employer to a third party then, in the absence of a contrary agreement, his/her inventions will in the circumstances described in subsection (1) belong to the employer and not to the third party, although of course the employer is free to assign all rights in the invention to that third party (*Defence Technology's Application*, SRIS O/77/93, noted TPD 16124).

Ownership of employee inventions by an employer

—The basic rule

39.07

The introductory phrase of subsection (1) simply sweeps away any rule evolved under the common law before June 1, 1978 (*Harris's Patent* [1985] RPC 19). This renders precedents decided under the common law of no assistance for subsection (1)(a) cases and of only limited help in subsection (1)(b) cases. The factual situation can be proved under subsection (1)(a) either by reference to the employee's "normal duties" or to other duties "specifically assigned to him", whereas subsection (1)(b) provides a third gateway through which an employer can claim rights, by reference to the employee's "particular responsibilities" and an ensuing "special obligation", though still provided that the invention was made within the scope of the duties of that employee.

Although the question of onus of proof under section 39 is not free from doubt, the better view is that an employee will own his invention by virtue of subsection (2) unless his employer can prove that the situation under either part of subsection

PART I, SECTION 39]

(1)(a) or under subsection (1)(b) exists in fact. However, in entitlement proceedings under section 8, 12, 37 or 82, the Comptroller holds the view that the referrer has the onus of proving its contentions. This view, based on section 7(4), i.e. when a patent application has already been filed, is open to the criticism that it overlooks the effect of section 39(2). It is submitted that the better view, supported by *Harris's Patent* (*supra*), is that, when section 39 is under consideration, the onus should be on the employer to show that the facts correspond to one of the situations in section 39(1) irrespective of whether it was the employer or the employee who was the applicant of the disputed application.

For each of the three gateways of subsection (1) a two-stage inquiry is required, the first stage being broadly common to each of these, viz. the establishment of the actual duties of the employee. The second stage is then: (in both parts of subs. (1)(a)) consideration of the circumstances in which the invention was made; and (in subs. (1)(b)) consideration of the particular responsibilities and obligations of the employee. As *Harris* (*supra*) shows, the Comptroller or court will not be satisfied with job titles but will "lift the veil" to establish the detailed facts.

These facts will often show that a person, though an employee, engages in a number of activities at different times. Not all those activities may be "duties" of employment at all. For example, the position of university lecturers is particularly obscure in relation to their research activities if they are engaged primarily to teach, with spare time allowed for research, but no obligation to carry it out. The position of such persons was discussed by W. R. Cornish in "Rights in university innovations: The Herchel Smith lecture for 1991" ([1992] EIPR 13).

Subsections (1) and (2) are mutually exclusive as between employer and employee. It is submitted that this overrides the Comptroller's discretionary powers under sections 8 and 37 to grant a patent to joint proprietors where these would be employer and employee and confirms the position under the 1949 Act, as decided in *Patchett v. Sterling* ((1955) 72 RPC 50 (HL)). However, in *Szuca's Application* (SRIS O/27/88, noted IPD 11014) (decided under s. 37), ownership was awarded to the employee, but with a free licence under the patent to the employer. The Comptroller stated that joint proprietorship was unattractive, but did not suggest (as it seems he should have) that the law precluded this.

In *Pearl's Patent* (SRIS O/209/87) the Comptroller did not accept an argument that conception of an invention outside working hours fell outside the scope of an employee's duties, while accepting that the invention was not made in the course of the referrer's normal or specifically assigned duties for the purposes of subsection (1)(a). The decision can be criticised because, for the purposes of subsection (1)(b), it must first be shown that the invention was made in the course of the duties of the employee, before proceeding to focus on the "special obligations", i.e. more than the general duty of fidelity.

The Comptroller has been prepared to hold (in an uncontested case) that all rights in an invention belong to the employer when the inventor had apparently been employed to carry out duties relating to the invention (*Travenol Laboratories' Application*, SRIS O/45/90, noted IPD 13141); but in *Hamill's Application* (SRIS O/149/92), he was careful to find that the invention had been made in the course of the normal duties of the employee and was the type of invention which could be expected to result from the carrying out of those duties. In *Defence Technology's Application* (SRIS O/77/93, noted IPD 16124), the referrer failed to prove his invention was not made in those circumstances. In an interlocutory application in a copyright case, it was held not to be unarguable that "moonlighting" falls within the phrase "in the course of employment" (*Missing Link Software v. Magee* (1989) FSR 361). Decisions given by the Comptroller on entitlement and inventorship disputes prior to 1990 were reviewed by T. Z. Gold ([1990] EIPR 382).

[PART I, SECTION 39

—The employee's normal duties

39.08

In *Harris's Patent* ((1985) RPC 19), the "normal duties" of an employee were defined as the actual duties which he was employed to do. Thus, an employee's "normal duties" will be those defined by his contract of employment, including additional terms which may be implied, e.g. the duty of good faith and terms which are incorporated from collective agreements between employers and trade unions, from custom and practice, and from ancillary documents such as pre-employment correspondence, engagement letters, handbooks, works rules, notices on notice boards, etc. In *Harris* (*supra*), it was held never to have been part of the duties of the employee to turn his mind to solving technical problems.

Harris also settled the controversy over the scope of the implied term of an employee's duty of good faith, sometimes referred to as the duty of fidelity: it is co-extensive with, and does not go beyond, contractual duties. In this, *Harris* followed *United Sterling v. Felton and Mannion* ((1974) RPC 162) in which it was stated that the duty of fidelity expires at the moment the contract of employment terminates, though there is a continuing obligation not to disclose the employer's confidential information (*Paccenda Chicken v. Fowler*, [1986] FSR 291 (CA)). It should be noted, however, that contractual duties beyond that of fidelity may be implied (*Attorney-General v. Guardian Newspapers* (No. 2), ([1969] 2 FSR 181; [1988] 3 All ER 545, the "Spycatcher" case).

In *Secretary of State for Defence's Application* (SRIS O/135/89, noted IPD 13063), the Comptroller saw no distinction between "official" and "normal" duties, and, where research workers had investigated whether a particular topic should become an approved research product, this was regarded as part of their normal duties. In *British Gas's Application* (SRIS O/176/92), the employed inventor was unsuccessful in his claim to ownership. Some years after he had left his employer's service division and while working on his own initiative, though with the knowledge of the employer and using the employer's materials, the invention was made. The inventor reported this and suggested the filing of a patent application. In these circumstances the invention was held to have been made during the course of the inventor's normal duties. Likewise, in *Greater Glasgow Health Board's Application* (SRIS O/136/94), the inventor was employed as a clinical hospital registrar and research facilities were made available to him. It was held that his normal duties included trying to improve patient treatment and that this included considering the modification of an existing ophthalmic instrument.

—Duties specifically assigned to employee

39.09

In *Secretary of State for Defence's Application* (SRIS O/135/89, noted IPD 13063), specifically assigned duties were stated to be duties which are not the standard or everyday duties for which a person is normally employed. Given that it is an implied term of a contract of employment that an employee must obey lawful orders, and that an order to carry out duties outside the contract is a breach of that contract and is thus unlawful (unless an employee agrees and there is some consideration to support the consensual variation), an employee who carries out specifically assigned duties under protest and reserving his position may not be caught by subsection (1)(b); and see para. 39.12. For a discussion of an employee's duties falling outside of his normal duties, but specifically assigned to him, see the article by B. Bercusson ([1980] EIPR 257).

—Performance of normal or specifically assigned duties

39.10

The second stage of inquiry under subsection (1)(a) is concerned with whether the performance of the duties, as established in the first stage, is expected to result

PART I, SECTION 39]

in an invention. *Harris's Patent* ([1985] RPC 19) settled that the words "an invention" have a narrower meaning than "any invention", but are wider in scope than "the invention the subject of the dispute". But it is still unclear whose expectations are decisive, the employer's or the employee's, and whether the time of the expectation is the date of commencement of the duties in question or the date when the invention is made.

It is arguable that subsection (1)(a) achieves the same result as had been reached by 1977 under the common law, albeit by a different route. Thus, in *Electrolux v. Hudson* ([1977] FSR 312), a clause in a contract of employment under which the employer claimed ownership of an employee's invention was declared void as being wider than required to protect the employer's legitimate interest and therefore against public policy and in restraint of trade, in effect for not being confined to inventions flowing naturally from the performance of the employee's duties. On this basis former precedents may still have some persuasive value.

39.11 —Employees with special obligations

Subsection (1)(b) provides the third gateway whereby an employer can establish ownership of an invention made by an employee. The invention must still be one made "in the course of the duties of the employee". Then, in addition, the employee must be one who, at the relevant time, had a special obligation to the employer, arising from the nature of his duties and responsibilities, to further the interest of the employer's undertaking. The omission of "normal" in the reference to "duties" is no doubt deliberate and in contrast to subsection (1)(a). Subsection (1)(b) clearly covers employees in senior management whose duties are not so closely definable as to make "normal" meaningful in relation thereto. Thus, in *Pearl's Patent* (SRIS O/209/87), a works manager was held not to have discharged the onus on him to show that he did not have an obligation which extended to an invention he made at a time when he had been instructed not to involve himself in research and development matters. However, just how far down in the hierarchy of a given organisation one can go before an employee will cease to be covered by subsection (1)(b), irrespective of his inventions being covered by subsection (1)(a), will always be a difficult question.

In *Defence Technology's Application* (SRIS O/77/93, noted IPD 16124), a high-grade employee was seconded to a key position in the organisation of a third party and made an invention, the ownership of which he disputed. There were no written provisions as to ownership of inventions by the employer, the employee or the third party. It was held that the employee owed a special obligation to further his employer's interests and that, on the balance of probabilities, the employer would have assigned the rights under the invention to the third party. The fact that, shortly after making the invention, the employee became employed by the third party without any real change in his job duties but under a contract which did deal with ownership of inventions, supported the finding that the invention made during the secondment should also belong to the third party.

In *Rutter and Pope's Applications* (SRIS O/143/94), the applicants had been joint managing directors of a company. Although the normal duties of each of them did not include the making of inventions, their executive position was such that their invention rights were owned by that company. A less clear case of an inventor having a special obligation to further the interests of his employer because of his seniority and executive responsibilities is *Sjaeng's Patent* (SRIS O/131/94).

39.12 —Employee holding invention on constructive trust for employer

Where it is established that the employee is entitled to the benefit of an invention held on trust for him by the employer, the common law of constructive trusts will

[PART I, SECTION 39

come into force, as discussed in the book by J. Phillips and M. J. Hootsman, *"Employees' Inventions in the United Kingdom"* (ESC Publishing Ltd., 1982). In such a trust the employee not only takes the benefit, but also the liabilities, of the resulting trusts (*Triplex v. Scamm*, (1938) 55 RPC 21). The employee is then entitled to compensation for any expenditure he may have incurred in developing and protecting the invention, as was required in *Hindmarch and Homer's Application* (SRIS O/158/80, noted IPD 3147). In the case where an employer solicits the aid and services of an employee beyond the scope of his normal duties without any "consideration" or promise of remuneration subsequent to his performance of the requested services, the employee may have a quasi-contractual remedy of quantum meruit to recover the value of those services from the employer.

Application of section 39 to particular cases

39.13

The application of the principles set out in section 39(1) to particular facts usually arises in proceedings under section 8, 12, 37 or 82 (determination of entitlement to patent ownership). Decisions on these are therefore discussed mainly in the commentary on section 37 at para. 37.12, but see also para. 8.10. The applicability of section 39 to members of the academic staff of a university has been discussed by W. R. Cornish, see para. 39.07, along with the rather different rule for ownership of copyrights created by an employee.

Decisions under the common law

39.14

Precedents decided under common law principles should be treated with considerable caution, see para. 39.07. This is partly due to the inconsistency of pre-1978 cases such as *British Syphon v. Homewood* ([1956] RPC 225 and 330) and *Selz's Application* ([1954] 71 RPC 158 (PAT)); and partly because these cases were generally concerned to determine, as a first step, whether the invention was made "in the course of employment", for example as in *Hindmarch and Homer's Application* (SRIS O/158/80, noted IPD 3147, decided under s. 56 [1949]). It is submitted that the phrase "duties of an employee" in section 39(1) has a narrower meaning. Whether an act was "in the course of employment" has been the subject of numerous labour law cases involving, e.g. employers' vicarious liability for their employees' acts, and is closely bound up with the concept of authorisation, express or implied, for a given act.

Determination of inventor ownership disputes

39.15

An inventorship dispute can arise under section 13 (mention of inventor) or under section 8, 12, 37 or 82 (determination of question of entitlement). Employee-employer ownership disputes on "existing patents" are resolved under section 56 [1949]. The procedure for resolving such disputes is discussed in the commentaries on these sections.

Settlement of disputes by employers

39.16

Employers will naturally seek to settle inventorship disputes with, or between, their employees by informal and internal procedures. If this is to be done, it is important that the procedures used by the employer should be fair, not too lengthy, and generally comply with rules of natural justice.

There is an overriding implied term in a contract of employment that employers will not, without reasonable and proper cause, conduct themselves in a manner

PART I, SECTION 39]

calculated or likely to destroy or seriously damage the implied (or express) obligation of trust and confidence between employer and employee, see *United Bank Limited v. Akhtar* ([1989] IRLR 507 (EAT)). The application of this implied term can prohibit actions which would on the face of the contract be legitimate for the employer, and in so far as an express contractual term gives an employer a discretion, it should not be exercised in a capricious way, see *White v. Reflecting Roadsigns Limited* ([1991] IRLR 331 (EAT)).

In an interlocutory case, *News v. British Airways* ([1992] IRLR 575), the Court of Appeal stated that there was an implied contractual duty of "good faith" on the employer, requiring fair dealing with employees, and a breach of this duty could be restrained by an injunction. It may therefore be argued that the implied term enunciated in *Akhtar*, *supra* (and possibly the implied duty found in *News*) is a fundamental term in the contract of employment a breach of which entitles an employee (with a qualifying period of service, currently of two years) to resign and claim compensation for unfair constructive dismissal under section 57(1)(c) of the Employment Protection (Consolidation) Act 1978 (c. 44), see in general *Western Excavating v. Sharp* ([1978] QB 761; [1978] 1 All ER 713 (CA)).

39.17 Contrast with employer ownership of copyrights and design rights created during employment

Sections 11(2) and 215(3) [1988] have effect respectively to pass first ownership of copyrights and design rights created by an employee "in the course of his employment" automatically to the employer, subject in the latter case only to the prior right of one who commissioned the making of the design. A topography right is treated in the same way as a design right, except that here the statutory provision may be varied by a written agreement (Design Right (Semiconductor Topographies) Regulations 1989, S.I. No. 1100, rr. 2, 5).

First ownership of registered designs is also now governed as for a design right (Registered Designs Act 1949 (c. 88), s. 2(1B) as inserted by s. 267 [1988] and as reprinted in Sched. 4, para. 2(1B) [1988]). If, as seems to be clearly the case, this phrase is wider in scope than the combined effect of the three gateways of section 39(1), then decisions in relation to these other types of intellectual property rights will have no direct effect on the interpretation of section 39.

Conversely, having regard to the lack of definition of "invention" in section 39 and the presence in the introductory passage of subsection (1) of the phrase "for the purposes of this Act and all other purposes" (emphasis added), it may be that section 39 has the unexpected effect of modifying the ownership regimes in the above-mentioned Acts and Regulations if the design or copyright work can be said to be an "invention"; and this may be a clue to the interpretation of "other protection" in section 43(4), see para. 43.05.

Aside from the argument whether a design or copyright work is nevertheless also an "invention", a dichotomy between employees' rights in different species of intellectual property will often arise from the same, or closely associated, acts leading to a position where, even though an employee may own patent rights because the employer is unable to establish any of the criteria of subsection (1), nevertheless the employer may own associated copyrights, design rights, registered designs, etc., because these have been created by the same employee "in the course of his employment".

39.18 Employees' immunity under associated copyrights and design rights (subs. (3))

To alleviate the position set out in para. 39.17, subsection (3) was added, and an amendment made to section 43(4), by the 1988 Act (Sched. 5, para. 11). Under new

[PART I, SECTION 39]

subsection (3), where by virtue of subsection (2) an invention belongs to an employee, rather than to the employer, then nothing done by or on behalf of the employee, or his successor in title, for the purpose of prosecuting an application for a patent, or by any person for the purpose of performing or working the invention, "shall be taken to infringe any copyright or design right" in "any model or document" to which the employer is entitled, rather than the employee. It seems slightly odd that subsection (3) does not include a reference to registered designs, but a possible explanation is that the legislator could not conceive of a registrable design as an "invention", given the exclusions from registrability in section 1 of the Registered Designs Act 1949, as amended by the 1988 Act.

Thus, employers will not be able to use these other intellectual property rights to prevent employees from obtaining patents on their own inventions. Also, new subsection (3)(b) is presumably intended to provide a defence in any action for infringement of any copyright or design right arising from a model or document to which the employer is entitled. However, this provision may not be as wide as it seems at first sight. It is clearly intended to apply to copyrights of which the employee in question is the author (designer) but, as regards documents or models created by the employee's colleagues, the resulting copyright or design right may not perhaps be a right "between him (the employee) and the employer".

The amendment to section 43(4) has the effect that any reference to "patent" in section 39 extends to a "patent or other protection" granted, whether under the law of the United Kingdom or otherwise. This provision is discussed further in para. 43.05. However, in its application to section 39(3) (the word "patent" not appearing otherwise in s. 39), it is difficult to see how United Kingdom law can effectively provide a defence to an action brought in another country for infringement of an intellectual property right in that country unless perhaps a United Kingdom court would grant an injunction against the employer entity to prevent it from seeking to assert its foreign "protection" contrary to section 39(3)(b), as extended by section 43(4). Also, because copyrights (and design rights) are not "granted", the provision may be ineffective anyway, see para. 43.05.

PRACTICE UNDER SECTION 39

Keeping of records

Whether section 39(1) applies to an invention made by an employee depends on the circumstances in which an invention was made. In the interest of both employer and employee, it is most desirable to set out in writing the employee's normal duties, whether the employee has any special duties or obligations, to record any change in the employee's normal duties and when any other duties are specifically assigned thereto with the employee's consent, as well as the consideration therefor.

It must be a question of fact whether an employee might reasonably be expected to make inventions in carrying out his/her normal, or assigned and accepted, duties. An attempt can be made to deal with this point in the contract of service, but in cases of doubt past experience of the employer as to whether a particular class of employee (e.g. a sales engineer) has made, or been expected to make, inventions as a result of carrying out the employee's normal duties might be relevant in determining ownership of the invention.

In the interests of certainty it may be desirable, before a patent application is filed, that an employee-inventor be asked to sign a declaration as to the ownership of the invention. In any event, personnel records of inventors should be maintained for at least one year after the patent has ceased to have effect, see rule 59(2) reprinted at para. 40.02. An attempt may be made to claim inventorship many years after the application was filed, see para. 13.10. Papers by K. Hodgkinson in *The*